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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/241,083	02/01/1999	HIROYUKI KOSUDA	1080.1071/JD	8170

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WASHINGTON, DC 20001

EXAMINER

RETTA, YEHDEGA

ART UNIT	PAPER NUMBER
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2162

DATE MAILED: 12/05/2001

14

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.  
09/241,083

Applicant(s)  
Kosuda et al.

Examiner  
Yehdega Retta

Art Unit  
2162



— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on Aug 9, 2001

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 1-10 is/are pending in the applica

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from considera

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 1, 2, and 7-10 is/are rejected.

7) ☒ Claim(s) 3-6 is/are objected to.

8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirem

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) ☒ The proposed drawing correction filed on Dec 26, 2000 is: a) ☒ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☒ All b) ☐ Some\* c) ☐ None of:

- ☒ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

20) ☐ Other:

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**DETAILED ACTION**

***Response to Amendment***

1. This office action is in response to amendment filed August 9, 2001.

***Response to Arguments***

2. Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 1, recites, "...and both transmitting the to the destination address and printing ...". A word is omitted between the "the" and "to the". The " receipt" is canceled by mistake. Correction is required.

6. Claims 2-6 are rejected since they depend on claim 1.

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*Claim Rejections - 35 USC § 103*

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 2, 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tognazzini U.S. Patent No. 5739512, in view of Internet banking; How far, how fast?, Marshall, Jeffery, US Banker, v08, n3, p66-68, Mar 1998 (herein after Marshall).

9. As per claim 1, as amended, Tognazzini teaches a display device; means for controlling the display; performing input operation in accordance with a display on the device (see col. 5 lines 17-28 and fig. 2), performing on the display device a screen display in which a destination electronic mail address for receiving a transaction record is able to be input through the input means and a screen display providing options to the consumer to choose from, the options being to transmit the transaction record to the destination address or print the transaction record at the facility (see col. 6 lines 17-25 and fig. 5). Tognazzini teaches when the cash register generates a receipt a transmitter sends an electronic copy of the receipt to the electronic mail address. Tognazzini also discloses the electronic copy being digitally signed by the customer before being sent to the electronic mail address or customer's smart card receiving a copy of the digital receipt, process

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the digital signature and then return the signed receipt to the cash register for sending the electronic receipts (see col. 5 lines 32-55). Tognazzini does not teach providing the option to the customer to choose both transmitting the receipt to the destination address and printing (hard copy) at the facility. Marshall teaches that Web@TM display screen displaying an option for account statements, reports or transaction receipts to be printed online or e-mailed to the customer (see page 1 abstract). Marshall does not explicitly show that the information can be printed and emailed. Official notice is taken that is well known in the art of Internet to provide an option to print and email information displayed on a computer screen. Online information services such as publications, news paper or articles are displayed with an option to print and email. Therefore it would have been obvious to one of ordinary skills in the art at the time of applicant's invention to modify Tognazzini's paper less transaction by including an option to print and transmit the receipt to an email address. One would be motivated to have the option of printing a paper receipt, which is analogous to the digital receipt of Tognazzini, in order to verify the transaction at the facility, and in case of credit transaction in order to sign the transaction as taught by Tognazzini, and to receive electronic copy through electronic mail for the purpose of saving the information for later use, in case the paper receipt is lost.

10. As per claims 2, Tognazzini teaches display control means perform on the display device a screen display in which a record being able to be input (see fig. 2). Tognazzini does not teach a third screen display in which a number of transaction records are inputted. Marshall teaches a screen display in which a number of transaction records are inputted (see under statement

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selection and under transactions receipt). Therefore, it would have been obvious to a person of ordinary skill in the art at the time of invention was made to modify Tognazzini's transmitting of receipt to email address and Marshall's On-line banking for printing and emailing a summary of the transaction (see Marshall page 1) for the purpose of giving a customer control of their accounts and transactions.

11. Claims 7-9, recites similar limitation as claim 1, therefore the rejection of claim 1 applies.

12. Regarding claim 10, as amended, Tognazzini teaches displaying selection options to transmit a transaction receipt to a destination address or print the transaction receipt at the customer transaction facility (see col. 6, lines 17-25 and fig. 5). Tognazzini does not teach providing the option to the customer to choose both transmit the receipt to the destination address and print (hard copy) at the facility. Tognazzini teaches when the cash register generates a receipt a transmitter sends an electronic copy of the receipt to the electronic mail address. Tognazzini also discloses the electronic copy being digitally signed by the customer before being sent to the electronic mail address or customer's smart card receiving a copy of the digital receipt, process the digital signature and then return the signed receipt to the cash register for sending the electronic receipts, which is analogous to the print of the receipt. Tognazzini teaches transmitting the transaction receipt to pre-selected address however does not specifically teach display options to transmit the transaction receipt to a different address. Official notice is taken that is well known in the art of Internet to provide an option to print and email to any email address, information displayed on a computer screen. Online information services such as

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publications, news paper or articles are displayed with an option to print and email in which email address is entered. Therefore it would have been obvious to one of ordinary skills in the art at the time of applicant's invention to modify Tognazzini's paper less transaction by including an option to print and transmit the receipt to an email address. One would be motivated to have the option of printing a paper receipt, which is analogous to the digital receipt of Tognazzini, in order to verify the transaction at the facility, and in case of credit transaction in order to sign the transaction as taught by Tognazzini, and to receive electronic copy through electronic mail for the purpose of saving the information for later use, in case the paper receipt is lost. One would be motivated to send the transaction receipt to different location in order to be able to receive the information at convenient location, such as the office computer, laptop or palm or home computer.

***Allowable Subject Matter***

13. Claims 3-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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*Conclusion*

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Online services; Database; Weston; Feb/Mar 1998

UMI adds ProQuest enhancements, info; Computers in Libraries; Westport; Feb 1998;

Anonymous.

SIRS Researcher on the Web gets new features, Information Today; Medford; Apr 1998;

Anonymous.

New terminals to make Pattee user-friendly; Lisa Harrlander, Collegian Staff Writer;

Sept, 16 1996.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (703) 305-0436. The examiner can normally be reached on Monday-Friday from 7:00 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703) 305-8469.

Any response to this office action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

or:

(703) 308-5397, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive Arlington, Virginia, (Receptionist).



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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

A handwritten signature in black ink, appearing to read "Eric W. Stamber". The signature is fluid and cursive, with the first name "Eric" and last name "Stamber" clearly distinguishable.

ERIC W. STAMBER  
PRIMARY EXAMINER

Examiner  
Yehdega Retta  
Art Unit 2162  
November 28, 2001